

Any Dkt No. STA 0290 R

S/N: 09/853.382
Reply to Office Action of March 14, 2003

Remarks

Reconsideration and reexamination of the above-identified patent application, as amended, are respectfully requested. Upon entry of this Amendment, claims 1-6 and 13-17 are pending in this application. In this Amendment, the Applicant has added new claims 13-17 and has cancelled claims 7-12.

Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,411,783 issued to Mahn ("Mahn"). The Applicant appreciates the Examiner's guidance in suggesting that the Applicant use the closed transition phrase "consisting of" instead of the phrase "comprising" in independent claim 1. Presumably, the use of the closed transition phrase would patentably distinguish the claimed invention as recited in claims 1-5 over Mahn and thereby put claims 1-5 into a condition for allowance. As a result, the Applicant has added new claims 13-17 which are identical to claims 1-5 with the exception of the closed transition phrase being used. Therefore, the Applicant believes that new claims 13-17 are in a condition for allowance.

The Applicant respectfully traverses the rejection of claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Mahn. In general, the claimed invention is directed to a cover sheet for impressing a pattern on an emblem while Mahn is directed to applying an emblem 11, 30 to a cloth substrate 15 such as a shirt. Mahn's emblem may or may not have a pattern (FIG. 2 of Mahn illustrates no pattern on thermoplastic elastomer layer 14 of the emblem; and FIG. 5 of Mahn illustrates a pattern (indicia 35 formed by debossed areas 37) on thermoplastic elastomer layer 31 of the emblem).

The Examiner's position is that the elastomer layer 14, 31 of Mahn comprise the identical material as that of the claimed release coating. In paragraph 4 of the previous Office Action mailed on June 21, 2002, the Examiner noted that the claimed release coating

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may be selected from the group consisting of silicone, vinyl, and urethane compounds as recited in dependent claim 3. The Examiner further noted that Mahn's elastomer layer 14, 31 may comprise polyurethane or vinyl compounds (citing col. 2, lines 33-53 of Mahn). Therefore, the Examiner posited that Mahn's elastomer layer 14, 31 is equivalent to the claimed release coating and, as a result, it would be inherent that Mahn's elastomer layer 14, 31 possesses the same properties as the claimed release coating.

The Applicant respectfully disagrees with the Examiner's position that Mahn's elastomer layer is equivalent to the claimed release coating. Col. 2, lines 33-53 of Mahn teaches that the elastomer layer 14, 31 is a "thermoplastic" elastomer layer which exhibits plastic flow at elevated temperatures. Mahn further teaches that particular thermoplastic elastomers include "thermoplastic polyurethane elastomer" and "ethylene vinyl acetate copolymer thermoplastic." (Emphasis added.) Accordingly, Mahn's elastomer layer 14, 31 may comprise polyurethane or vinyl compounds as long as such compounds are of the "thermoplastic" variety which exhibit plastic flow at elevated temperatures.

The Applicant respectfully submits that the claimed release coating does not comprise the identical material as Mahn's thermoplastic elastomer layer because the claimed release coating exhibits heat and pressure resistant impressions. The impressions are heat and pressure resistant in order to impress a pattern formed by the impressions onto an emblem during the application of heat and pressure. Such impressions exhibited by the claimed release coating could not be heat and pressure resistant for the purpose of impressing the impressions on an emblem if the material of the claimed release coating included thermoplastics. Furthermore, as noted by the Examiner, the claimed release coating may be selected from the group consisting of silicon, vinyl, and urethane compounds. However, such compounds are not "thermoplastic" compounds as taught by Mahn. Therefore, the claimed release coating is not equivalent to Mahn's thermoplastic elastomer layer 14, 31 as the claimed release coating and Mahn's thermoplastic elastomer layer do not comprise identical material.

As indicated above, Mahn's thermoplastic layer 31 may have debossed areas 37 forming a pattern 35. The claimed release coating has a debossed impression forming a

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pattern. Therefore, the Examiner posited that thermoplastic layer 14, 31 anticipates the claimed release coating. The Applicant respectfully posits that the claimed release coating patentably distinguishes over Mahn's thermoplastic layer 14, 31 as the claimed release coating exhibits an impression suitable for impressing a pattern on an emblem under the application of heat and pressure.

Independent claim 1 is as follows:

1. A cover sheet for impressing a pattern on a thermoplastic surface of an emblem, comprising:
a base layer;
a heat application release coating on the base layer;
said release coating exhibiting a heat resistant and pressure resistant debossed or embossed impression complementing the pattern; and
said cover sheet, when placed with its release coating against and in registry with the thermoplastic surface of an emblem and heat and pressure are applied on said cover sheet and toward the emblem, the pattern is formed on the thermoplastic surface of the emblem. (Emphasis Added.)

As such, the impression which is exhibited on the release coating is itself "heat resistant and pressure resistant." As claimed, the impression is heat and pressure resistant in order to impress its pattern on the thermoplastic surface of an emblem when placed in registry with the thermoplastic surface while heat and pressure are applied. Mahn does not teach or suggest that debossed areas 37 of thermoplastic layer be "heat resistant and pressure resistant" as claimed nor suggest that the pattern 35 have these characteristics in order enable impression of the pattern onto the thermoplastic surface of an emblem. In sum, Mahn does not teach or suggest any need for debossed areas 37 to resist the application of heat and pressure in the formation of complementary thermoplastic impressions on an emblem.

The Examiner, citing col. 3, lines 52-60 of Mahn, posited that Mahn's thermoplastic elastomer layer is heat and pressure resistant. The Examiner posited that col. 3, lines 52-60 "explains that, in attaching the [thermoplastic] elastomer layer to a substrate, heat and pressure are applied, which softens the adhesive but does not soften the [thermoplastic] elastomer layer."

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Col. 3, lines 52-60 of Mahn recites:

These [emblems made of upper thermoplastic elastomer layers and lower thermoplastic adhesive layers laminated together] can then be applied to a cloth substrate by applying heat at about 350° F. and pressure of 20-30 psi against the upper thermoplastic elastomer layer toward the cloth substrate for about 5 to 10 seconds (preferably 6 seconds), causing the adhesive layer to soften, penetrate the cloth substrate and bond the thermoplastic elastomer layer to the cloth substrate.

As such, col. 3, lines 52-60 does recite that heat ("about 350° F") and pressure are applied which softens the adhesive layer and that this softened adhesive layer bonds the thermoplastic elastomer layer to the substrate. Mahn further teaches that both the elastomer layer and the adhesive layer are thermoplastics. (See the Abstract; and col. 3, lines 3-60 of Mahn.) Accordingly, if heat and pressure softens the thermoplastic adhesive layer then the heat and pressure would also soften the thermoplastic elastomer layer. Therefore, col. 3, lines 52-60 of Mahn do not teach or suggest that the heat and pressure "does not soften the [thermoplastic] elastomer layer" as posited by the Examiner. Furthermore, contrary to the Examiner's position that Mahn's thermoplastic elastomer layer is heat and pressure resistant, col. 3, lines 3-6 of Mahn suggests otherwise.

Col. 3, lines 3-6 of Mahn recites:

The thermoplastic elastomer for use in the present invention should have a melting temperature of from about 250° F. up to 400° F. or higher, and preferably around 300° F. This, of course, will vary widely depending upon the particular application and in particular the adhesive used. If a lower melting point adhesive is used, a thermoplastic elastomer with a lower melting point can also be employed.

Col. 3, lines 3-6 of Mahn suggests that the thermoplastic elastomer layer is not heat resistant (i.e., has a melting temperature) at the temperature ("about 350° F.") which is used to bond the thermoplastic elastomer layer to the cloth substrate as described in col. 3, lines 52-60 of Mahn. Therefore, the Applicant respectfully posits that Mahn does not teach or suggest a heat applied transfer process during which a cover sheet is used, and therefore

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does not address the cover sheet release coating including heat transmissibility as well as resistance to deformation of the impression exhibited on the release coating during the application of heat and pressure.

In view of the foregoing, the Applicant respectfully requests reconsideration and withdrawal of the rejection to the claims under 35 U.S.C. § 102(b).

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 4-5 under 35 U.S.C. § 103 as being unpatentable over Mahn for the reasons of record in view of the above arguments. Claims 4-5 depend from independent claim 1 and include the limitations therein. As a result, the Applicant respectfully requests reconsideration and withdrawal of the rejection to the claims under 35 U.S.C. § 103(a).

CONCLUSION

In summary, claims 1-6 and newly added claims 13-17 meet the substantive requirements for patentability. The case is in appropriate condition for allowance. Accordingly, such action is respectfully requested.

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If a telephone or video conference would expedite allowance or resolve any further questions, such a conference is invited at the convenience of the Examiner.

Respectfully submitted,

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